REMARKS

This Application has been reviewed in light of the Office Action mailed on August 24, 2009. Claims 3–6, 13–16, and 18–28 are pending in the application. Applicant respectfully requests reconsideration of the application in accordance with the following remarks.

I.   The Claims Fall Within a Statutory Class of Patentable Subject Matter

Claims 23–28 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection, as each of the pending claims falls within one of the statutory classes of patentable subject matter. Applicant further traverses the rejection because the claims satisfy at least one of the two tests articulated in the M.P.E.P.:

> A claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it:
> (A) "transforms" an article or physical object to a different state or thing; or
> (B) otherwise produces a useful, concrete and tangible result . . . .

M.P.E.P. § 2106(IV)(C)(2). For example, Claim 23 recites a computer program product, tangibly embodied in a machine-readable storage device, comprising instructions operable to cause a programmable processor to, *inter alia*, "convert the text content of the human-readable appearance of the print out to the canonical form of the text content," transforming the text content of the print out to the canonical form of the text content. Claims 25 and 27 also recite similar claims. Further, Claim 25 recites a work flow system comprising, *inter alia*, "means for printing a print out of the electronic document to be sent to the external entity," and Claim 27 recites a computer program product, tangibly embodied in a machine-readable storage device, comprising instructions operable to cause a programmable processor to, *inter alia*, "create a print out of the electronic document to be sent to the external entity." These claims recite printing or creating a print out, which transforms the electronic document into a paper document and produces a useful, concrete and tangible result. The claims clearly recite elements that place the claims within one of the statutory classes of patentable subject matter pursuant to 35 U.S.C. § 101. As such, Applicant respectfully traverses the rejection and requests reconsideration and allowance of the claims.

II.   The Claims Are Valid Over the Referenced Art

Claims 3–6, 13–16, and 18–28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0069179 to Slater *et al.* ("*Slater*") in view of U.S. Patent No. 6,634,559 to Shioda ("*Shioda*") and further in view of U.S. Patent Application Publication No. 2004/0193543 to Nord *et al.* ("*Nord*"). Applicant respectfully traverses the rejection and assertions and holdings therein, because the above cited art, whether individually or in combination, fails to teach, suggest, or disclose certain aspects of the present claims.[1]

The referenced art, either alone or in combination, fails to teach implementing a workflow system that generates printed out documents sent to and for use with external entities that do not exchange electronic documents with the workflow, but that then receives a modified version of the printed out document back from the external entity for reintegration into the workflow after validating the modified and printed out document. As admitted by the Office Action, the following elements are "not explicitly taught by the combination of Slater and Shioda":

- "receiving a modified print out at the workflow system back from the external entity, the modified print out comprising the print out sent to the external entity with a modification;"

- "validating the modified print out within the workflow system using the one or more control codes;"

- "integrating the validated and modified print out into the workflow; and"

- "continuing the workflow for the validated print out within the workflow system"

Office Action, Aug. 24, 2009, at 8. *Nord* is thus relied upon by the Office Action for teaching these elements. *Nord* fails to overcome the admitted deficiencies of the *Slater-Shioda* combination because *Nord* fails to teach at least the elements recited above. Specifically, *Nord* at least fails to teach "validating the modified print out within the workflow system using the one

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[1]   Applicant reiterates the arguments made in previous responses that the *Slater-Shioda* combination fails to teach the elements of the claims. For example, the *Slater-Shioda* combination fails to teach "one or more second control codes generated from the canonical form of the text content [that] authenticate the text content" as recited in example Claim 18. *Nord* also fails to teach this example element of Claim 18. As such, the combination of the referenced art is deficient, and Applicant respectfully requests reconsideration and allowance of the claims.

or more control codes" and "integrating the validated and modified print out into the workflow" as recited in example Claim 18.

A. The Claims Are Allowable Over *Nord*

Nord fails to teach the recited elements of example Claim 18. Put simply, *Nord* is directed to generating a digital copy of a legally valid document by simultaneously signing the printed and electronic copies of the document. *See, e.g., Nord,* Abstract. Specifically, *Nord* teaches "a method for a simultaneous, legally binding, signing of a paper- and a digital document being provided with a single unique identity, wherein only one signing provides a legally valid paper original of e.g. an agreement, contract or the like having a digital equivalence." *Nord* ¶ [0010]. *Nord* teaches that the "simultaneous signing of the corresponding filled-in paper- and digital original documents can . . . be accomplished through placing the paper original 50 on top and fitting the outlining of the corresponding underlying digital original 30 being displayed on a digitizing means 60, connected to the computer device 10." *Nord* ¶ [0067]. *Nord* then uses a unique identity appearing on both the digital and paper documents to verify that the unsigned documents are the same. *See Nord* ¶ [0067] (teaching that the "two originals 30, 50 to be simultaneously signed have the same unique code and that they thus constitute the same document" (emphasis added)). Further, "[a]n optical guide . . . can be provided for reading and, through the computerized device 10, enabling comparing, matching, the unique identification codes provided on the paper original 50 and on the respective underlying digital counterpart 30."[2] *Nord* ¶ [0067]. "The digitally signed original can then e.g. be sent with telecom. speed" to other parties. *Nord* ¶ [0069].

1. *Nord* Does Not Teach the "Validating" Element

As can be seen from the description above, *Nord* does not teach "validating the modified print out within the workflow system using the one or more control codes," as recited in example

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[2]   *Nord* goes on to teach that the "optical guide can furthermore scan, read, that the overlying paper original is positioned correctly on the digitizing means, i.e., fitting the outlining of the thereupon displayed digitial original, thus ensuring the signature's identical positioning on both originals within a predetermined threshold value." *Nord* ¶ [0067]. This indicates that the paper original is physically placed on top of the optical guide for the comparison of the unsigned originals.

Claim 18. Even a cursory inspection of *Nord* reveals that at least this element is absent from the reference. First, *Nord* explicitly states that the only step resembling validation of the document occurs <u>prior to</u> the simultaneous signing of the document. *See Nord* ¶ [0067]. In other words, *Nord* does not teach validating the document using control codes after it has been signed. Instead, *Nord* teaches that the identification appearing on the digital document is optically compared with the identification appearing on the paper document. *See Nord* ¶ [0067]. If the two identifications match, the two documents are assumed to constitute the same document, and the signor is free to simultaneously sign the paper and digital originals. Second, the present claims recite validating a document that has been modified by comparing control codes appearing <u>on the modified document</u> with control codes appearing <u>on the unmodified, or original, document</u>. In other words, the present claims recite comparing and validating two separate versions of a document: one modified and one unmodified, whereas *Nord* teaches comparing a digital and paper copy of the same document. Third, since the original electronic and paper copies are signed at the same time, there would be no reason for *Nord* to use one or more control codes to validate the document after it has been modified. In other words, the simultaneous signing of the digital and electronic copies obviates the need to validate the signed document since the printed document is necessarily identical to the digital document. This is further evidenced by the teaching of *Nord* that the unsigned documents are verified <u>prior to</u> the simultaneous signing. Therefore, *Nord* fails to teach at least this element of Claim 18, and thus fails to overcome the admitted deficiencies of the *Slater-Shioda* combination.

2. *Nord* Does Not Teach the "Integrating" Element

Further, *Nord* fails to teach "integrating the validated and modified print out into the workflow," as recited in example Claim 18. To the contrary, *Nord* teaches that simultaneously signing a paper and electronic copy of the document allows the electronic copy to be maintained in the workflow without having to scan, copy, or otherwise integrate the <u>modified</u> paper document back into the workflow. Moreover, *Nord* teaches away from scanning documents following a modification. For example, *Nord* states that the "processes of subsequent copying and scanning of signed contracts, agreements, deeds and the like documents" is "impractical, time-consuming, tedious and unnecessarily costly due to the manual effort incorporated" and

"demands extra equipment to be at hand in the form of e.g. bulky scanning and copying machines, a fact which ads [sic] to the inflexibility of the process as a whole." *Nord* ¶ [0006]. Therefore, *Nord* not only fails to teach this element of Claim 18, but actually teaches away from integrating the validated and modified print out back into the workflow as recited in example Claim 18. Thus, *Nord* again fails to overcome the admitted deficiencies of the *Slater-Shioda* combination.

3. *Nord* Does Not Teach Other Elements of Example Claim 18

Moreover, *Nord* suffers from additional deficiencies. For example, *Nord* fails to teach "generating control codes [including] one or more second control codes generated from the canonical form of the text content [that] authenticate the text content," as recited in example Claim 18. Rather, *Nord* teaches providing a filled-in digital document "with a unique identity e.g. in the form of a barcode, an alphanumerical sequence or another unique mark placed somewhere on the document before it . . . is printed as a paper original 50 of the filled out digital document 30." *Nord* ¶ [0066]. Assuming, *arguendo*, that the unique identity is analogous to a second control code, nothing in the *Nord* disclosure describes the unique identity as being generated from the canonical form of the text content. Therefore, *Nord* fails to teach at least this element of example Claim 18.

B. *Slater* Fails to Teach the "Validating" Element

The Office Action points to *Slater* to argue that certain passages and figures of *Slater* teach "verifying a document" to reject Claim 18.[3] Specifically, the Office Action points to Figures 4–6 and the associated text. To the contrary, Applicant respectfully submits that *Slater* teaches away from using control codes for verifying the text content. This is best illustrated by the cited passages of *Slater*, which teach that "the notary signature and/or other signature are validated as previously described, which often involves reconstructing the document to a previous state as previously described." *Slater* ¶ [0091]; *see also id.* at Fig. 6 and accompanying text. *Slater* further teaches that "[r]econstructing an electronic document ensures that the

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[3] As discussed above, the Office Action admits that *Slater* does not teach this element as recited in Claim 18.

electronic document has not been changed or altered and is also used when a digital signature is validated." *Slater* ¶ [0063]. Accordingly, *Slater* teaches away from using one or more control codes because *Slater* requires reconstruction of the entire document to a previous state, not using one or more control codes, to perform validation.

For the reasons above, and for those articulated in previous responses, the *Slater-Shioda* combination fails to teach, suggest, or disclose each and every element recited in example Claim 18. And as can be seen from the discussion above, the newly presented reference to *Nord* fails to overcome the admitted deficiencies of *Slater-Shioda*. For at least these reasons, Applicant respectfully requests withdrawal of the § 103 rejections, as well as reconsideration and allowance of Claim 18 and its dependents. Further, independent Claims 23, 25, and 27 recite certain elements analogous to those of Claim 18. For at least reasons similar to those discussed with regard to Claim 18, independent Claims 23, 25, and 27, as well as their dependents, are also allowable over the *Slater-Shioda-Nord* combination. Thus, Applicant respectfully requests that the rejections of those claims also be withdrawn and the claims be allowed.

<u>CONCLUSION</u>

Applicant has made an earnest attempt to place this case in condition for allowance. It is believed that all of the pending claims have been addressed. Applicant notes that the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all Claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

No fee is believed to be due. However, if this is incorrect, please apply any required fees or credits to PTO Deposit Account No. 06-1050, referencing the above attorney docket number.

Respectfully submitted,

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